

**REMARKS**

Claims 1 through 4 and 6 through 31 are currently pending in the application.

Claims 5 and 32 have been canceled.

This amendment is in response to the Office Action of August 14, 2002.

Claims 1 through 32 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 32 of prior United States Patent 6,221,753 (hereinafter referred to as the '753 patent). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant submits that a reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of one invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting under 35 U.S.C. § 101 does not exist. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

In the present application, Applicant submits that different embodiments of the presently claimed invention of independent claims 1, 9, 17, and 25 are being claimed than in corresponding claims of the '753 patent.

For instance, presently amended independent claim 1 of the present application is directed to "An assembly method for a semiconductor assembly, comprising . . . and encapsulating said first substrate and said second substrate with an encapsulation material." Clearly, a different embodiment of the invention is being claimed in presently amended independent claim 1 of the present application and claim 1 of the '753 patent as no element of the invention regarding encapsulation is set forth therein. Accordingly, presently amended claim 1 is allowable as an identical embodiment of the invention is not being claimed under 35 U.S.C. § 101 as that of the '753 patent.

Similarly, presently amended independent claim 9 of the present application is directed to "An assembly method for a semiconductor assembly, comprising . . . providing a second silicon substrate . . . ." Whereas the embodiment of the invention claimed in independent

claim 9 of the '753 patent has not such element of the invention set forth therein. Clearly, a different embodiment of the invention is being claimed in presently amended independent claim 9 of the present application than that of the '753 patent. Accordingly, presently amended claim 9 is allowable as an identical embodiment of the invention is not being claimed under 35 U.S.C. § 101 as that of the '753 patent.

Additionally, presently amended independent claim 17 of the present application is directed to "An assembly method for a semiconductor assembly, comprising . . . providing a first silicon substrate . . . ." Clearly, a different embodiment of the invention is set forth in presently amended independent claim 17 than that of the '753 patent because the embodiment of the invention of claim 17 of the '753 patent does not contain a first silicon substrate. Accordingly, presently amended independent claim 17 is allowable as an identical embodiment of invention is not being claimed under 35 U.S.C. § 101.

Applicant further submits that the embodiment of the invention set forth in presently amended independent claim 25 is not the identical embodiment of the invention set forth in independent claim 25 of the '753 patent because a first silicon wafer substrate is not an identical embodiment of the invention when compared to a first silicon substrate of the '753 patent. Accordingly, claim 25 is allowable as no double patenting under 35 U.S.C. § 101 is present because identical embodiments of the invention are not being claimed.

Applicant submits that claims 1 through 4 and 6 through 31 are clearly allowable.

Applicant requests the allowance of claims 1 through 4 and 5 through 31 and the case passed for issue.

Respectfully submitted,



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Enclosure: Version with Markings to Show Changes Made

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